

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MOHAN L. SANDUJA, CARL HOROWITZ,
ELLA MAYSLICH, and PAUL THOTTATHIL

Appeal No. 2001-1879
Application No. 08/919,448

ON BRIEF

Before KIMLIN, PAK and TIMM, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 8, 10-13, 15 and 16. Claims 1-7, 9 and 14, the other claims remaining in the present application, stand withdrawn from consideration pursuant to a restriction requirement.

Claim 8 is illustrative:

8. A coated steel workpiece coated by a process which comprises the steps of:

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(i) applying to an exposed face of the workpiece a composition comprising,

(a) a polymerisable material having at least one constituent selected from each of epoxy prepolymers, and urethane prepolymers;

(b) a monomer or prepolymer having at least one active group adapted to form graft polymerization linkages with the steel and with the polymerizable material, selected from the group consisting of hydroxyl, carbonyl, carboxyl, esters of carboxyl, amino, and epoxy;

(c) a catalytic initiator selected from the group consisting of ions of iron, silver, cobalt and copper; and

(d) a peroxide selected from the group consisting of benzoyl peroxide, methyl ethyl ketone peroxide, t-butyl hydroperoxide, and hydrogen peroxide; and

(ii) curing the resulting workpiece.

The examiner relies upon the following references as evidence of obviousness:

Hockensmith et al. (Hockensmith)	4,004,695	Jan. 25, 1977
Horowitz et al. (Horowitz '811)	4,105,811	Aug. 08, 1978
Horowitz et al. (Horowitz '955)	4,106,955	Aug. 15, 1978

Ferch	De 3,803,866	Aug. 10, 1989
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"Encyclopedia of Chemical Technology" 706-710, (4th ed., 1993).

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Appellants' claimed invention is directed to a coated steel workpiece, in general, and a telescopic boom, in particular. The workpiece is coated with a composition comprising epoxy and urethane prepolymers, a monomer or prepolymer having an active group which effects grafting to the steel, a catalytic initiator and a peroxide.

The appealed claims stand rejected under 35 U.S.C. § 103 as follows:

(1) Claims 8 and 13 over Horowitz '955 in view of Horowitz '811;

(2) Claims 8, 13, 15 and 16 over Horowitz '811 in view of Horowitz '955;

(3) Claims 10 and 11 over Ferch in view of Horowitz '955 and Horowitz '811;

(4) Claims 10-12 over Hockensmith in view of Horowitz '955 and Horowitz '811; and

(5) Claims 15 and 16 over Horowitz '955 in view of Horowitz '811 and the Encyclopedia of Chemical Technology.

Claims 10-12 stand rejected under 35 U.S.C. § 112, second paragraph. Also, claims 15 and 16 stand objected to under 37 CFR § 1.175(c).

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We consider first the examiner's rejections under 35 U.S.C. § 103. Horowitz '955 relates to coating steel articles with a composition that is similar to the one presently claimed with the exception of comprising a urethane prepolymer and a peroxide. Horowitz '811, on the other hand, while disclosing a composition comprising epoxy and urethane prepolymers, as well as a peroxide, is directed to coating an aluminum, not steel, substrate. It is the examiner's position that inasmuch as Horowitz '955 and Horowitz '811 disclose compositions which protect metal surfaces by grafting to the oxidized surface of the metals, it would have been obvious for one of ordinary skill in the art to formulate a composition comprising both epoxy and urethane prepolymers as a protective coating for steel.

While the examiner's rationale is not without logical appeal, we find that the disclosures of Horowitz '955 and Horowitz '811, in conjunction with appellants' Declaration of July 9, 1999, support the conclusion that the claimed subject matter, as a whole, would have been nonobvious to one of ordinary skill in the art. Neither Horowitz '955 nor Horowitz '811 is directed to coating metals, in general. Rather, Horowitz '955 is

singularly directed to coating steel articles, whereas Horowitz '811, likewise solely relates to coating aluminum articles. Horowitz '955 provides no teaching or suggestion that the disclosed coating composition can be applied to any metal other than steel, and Horowitz '811 provides no teaching or suggestion that the disclosed coating composition is suitable for any metal other than aluminum. When these facts are considered in combination with appellants' Declaration which demonstrates that an exemplified coating composition of the present invention provides significantly superior abrasion resistance compared to exemplified coating compositions of Horowitz '955 and Horowitz '811, we find that the evidence of nonobviousness outweighs the evidence of obviousness presented by the examiner.

The examiner is not convinced that the Declaration results are unexpected since Horowitz '811 teaches that the peroxide component regenerates the curing catalyst and the urethane component cross-links the composition and, accordingly, increased abrasion resistance would be expected by adding a polyurethane and a peroxide to the composition of Horowitz '955. The examiner does not explain, however, why the Declaration shows that the

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compositions of Horowitz '811, which contain a polyurethane and a peroxide have the lowest values for abrasion resistance of the three compositions tested. As for the compositing of Horowitz '811 having no filler, a filler is used in the inferior compositions of Horowitz '955.

The additional references cited by the examiner, Hockensmith, Ferch and the Encyclopedia of Chemical Technology, do not remedy the deficiencies of the combined teachings of Horowitz '955 and Horowitz '811 discussed above.

Claims 10-12 stand finally rejected under 35 U.S.C. § 112, second paragraph, because they are dependent upon claim 9, which has been withdrawn from consideration. Manifestly, the claims are not in proper format. However, the proper course of action for the examiner is to lodge an objection under 37 § CFR 1.75(c). Ex parte Porter, 25 USPQ2d 1144, 1147 (Bd. of Pat. Apps. and Int. 1992). See also MPEP § 608.01(n). Accordingly, we will not sustain the examiner's rejection under § 112, second paragraph. We trust that claims 10-12 will be rewritten in proper dependent form before any issuance.

Appellants have also traversed the examiner's objection to claims 15 and 16 under 37 CFR § 1.75(c) as failing to further

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limit the subject matter of a previous claim. However, traversals of objections entered by the examiner are not within the scope of our review. See MPEP § 706.01. We do note, however, that the examiner's objection is on sound footing inasmuch as § 112, fourth paragraph, does not allow for a dependent claim to be broader in any respect than the claim upon which it depends.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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CATHERINE TIMM)	
Administrative Patent Judge)	

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